

REMARKS

I. INTRODUCTION

Claims 10 to 22 are pending after this amendment adds new claims 19 to 22. New claims 19 to 22 find support throughout the Specification and the Figures. The Specification has been amended to correct a typographic error. The amendment and new claims do not add new matter.

Claims 10 to 15 have been rejected under 35 U.S.C. § 103(a), as obvious over the allegedly admitted prior art of the Specification in view of U.S. Patent No. 5,144,667 to Pogue, Jr. et al. (the Pogue reference). Claims 16 to 18 have been rejected under 35 U.S.C. § 103(a), as obvious over the allegedly admitted prior art of the Specification and the Pogue reference in view of U.S. Patent No. 6,282,180 B1 to Paneth et al. (the Paneth reference). Applicant hereby requests reconsideration of the application, in view of the following remarks.

II. THE 35 U.S.C. § 103(a) REJECTION BASED ON THE SPECIFICATION IN VIEW OF THE POGUE REFERENCE SHOULD BE WITHDRAWN

The Office Action rejects claims 10 to 15 under 35 U.S.C. § 103(a) as being obvious over the Specification in view of the Pogue reference. For a claim to be rejected for obviousness under 35 U.S.C. § 103, the prior art must teach or suggest each element of the claim, and it must also suggest combining the elements in the manner contemplated by the claim. See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 ; and In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990).

Independent claim 10 recites that “*before* the search signal is transmitted from the base station, determining the activation signal, wherein the activation signal is only recalled for the assignment.” (Emphasis added). The Office Action admits that the prior art discussed in the Specification does not include this element. The Office Action asserts that the Pogue reference teaches “that the search signal is transmitted from the base station, determining the activation signal, wherein the activation signal is only recalled for the assignment.” (Office Action, paragraph 2). However, this characterization of the Pogue reference fails to even allege that the activation signal is determined *before* transmitting the search signal. There is no teaching in the Pogue reference with respect to determining the activation signal *before* transmitting the search signal. In fact, the Pogue reference teaches

away from the method according to the present invention by explicitly teaching generating a random number *after* a reply is received from the remote. The Pogue reference states that, “[w]hen a reply is received, a random number R is generated and sent to the remote unit along with the Q which corresponds to the ID which was matched in the remote unit.” (Col. 5, lines 17 to 20; emphasis added). The Pogue reference indicates that the ID is unchanging by indicating that it may be chosen at the time of manufacture. (Col. 5, lines 46 to 48).

Therefore, since the Q corresponds to the ID, the only quantity which is calculated in the Pogue reference in the authentication method is random number R. Random number R of the Pogue reference is therefore the only element which may be considered analogous to the activation signal of the present invention. However, the Pogue reference explicitly states that the random number is generated *when* a reply is received. Therefore, the combination of the prior art discussed in the Specification and the Pogue reference cannot render obvious the subject matter of the present invention since the references do not teach or suggest that the activation signal is determined *before* the search signal is transmitted, as recited in claim 10.

With respect to claims 11 and 12, Applicant respectfully disagrees with the Examiner that the Specification describes prior art in which “*before* the search signal is transmitted by the base station, determining a response signal, wherein the remote control operation responds in accordance with the response signal after the activation signal is received.” (Office Action, page 3, lines 4 to 6; emphasis added). In fact, the Specification makes clear that, in the prior art, for the challenge or response calculation to be carried out in less than three milliseconds, that user-specific integrated circuits (ASIC) are used because a time response signal is required. (Specification, page 1, lines 15 to 18). These special circuits are necessary due to the fact that the prior art does not utilize the method according to the present invention of determining the activation signal *before* the search signal is transmitted from the base station. Since this claimed element is not taught in the Specification’s discussion of prior art or in the Pogue reference, claims 11 and 12 cannot be rendered obvious by the Specification in view of the Pogue reference.

In addition to the above, claims 11 to 15 depend from independent claim 10, and are therefore allowable for at least the same reasons presented above in support of the patentability of claim 10. It is therefore respectfully requested that the § 103(a) rejection of claims 10 to 15 based on the Specification and the Pogue reference be withdrawn.

III. THE 35 U.S.C. § 103(a) REJECTION BASED ON THE SPECIFICATION AND THE POGUE REFERENCE IN VIEW OF THE PANETH REFERENCE SHOULD BE WITHDRAWN

The Office Action rejects claims 16 to 18 under 35 U.S.C. § 103(a) as being obvious over the Specification and the Pogue reference in view of the Paneth reference.

Independent claim 16 recites that:

the arrangement for performing one of the causing and the evaluating
determines the activation signal before a transmission of the search signal
from the base station occurs, and the arrangement for performing one of the
causing and the evaluating only recalls the activation signal for an assignment
....

(Emphasis added). Claim 16 therefore has a limitation similar to that of claim 10 discussed in Section II above. For the same reasons recited above in support of the patentability of claim 10, claim 16 is not obvious over the Specification and the Pogue reference. The Paneth reference is cited only for its teaching with respect to a non-volatile memory. The Specification, the Pogue reference, and the Paneth reference fail to teach or suggest determining the activation signal *before* transmission of the search signal. Therefore, combining the Paneth reference with the Specification and the Pogue reference does not cure the critical deficiencies noted in Section II above.

Claim 17 depends from independent claim 16, and is therefore allowable for at least the same reasons presented above in support of the patentability of claim 16. Claim 18 is an independent claim with substantially similar limitation to that quoted above from claim 16, and is therefore allowable for at least the same reasons cited above in support of the patentability of claim 16. It is therefore respectfully requested that the § 103(a) rejection of claims 16 to 18 based on the Specification, the Pogue reference, and the Paneth reference be withdrawn.

IV. NEW CLAIMS

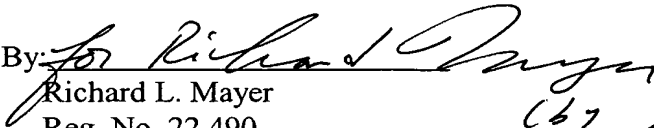
New claims 19 to 22 depend from claim 10 and are therefore allowable for at least the same reasons cited above in support of the patentability of claim 10.

V. CONCLUSION

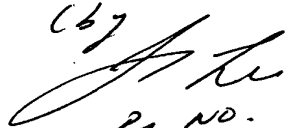
In light of the foregoing, Applicant respectfully submits that claims 10 to 22 are in condition for allowance. Prompt reconsideration and allowance of the present application is therefore earnestly solicited.

Respectfully submitted,

Dated: March 14, 2002

By: 
Richard L. Mayer
Reg. No. 22,490

KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200


R. NO.
36,197 |

CUSTOMER NO. 26646
PATENT & TRADEMARK OFFICE

AMENDMENT VERSION WITH MARKINGS**RECEIVED**

APR 01 2002

Technology Center 2600

IN THE SPECIFICATION:

A marked-up version of the paragraph beginning at page 3, line 22 of the Specification follows:

The remote control operation has at its disposal a transmitting/receiving device 21 corresponding to base-station-side transmitting/receiving device 11, for receiving signals transmitted by base station 10 or for transmitting signals to base station 10. By analogy to the base station, a microprocessor 23 is connected downstream of transmitting/receiving device 21, the microprocessor controlling the operation of remote control operation 20, especially undertaking the evaluation of the signals coming in via transmitting/receiving device [22] 21, initiating subsequent measures as a function of the results, and monitoring the generation of output signals. Microprocessor 23 has assigned to it a memory unit 24, wherein assignment information is stored for assigning remote control operation 20 to a base station 10. Stored for this purpose -- by analogy to base station 10 -- are a serial number 15, a group number 25, a manufacturer code 27, as well as an encryption keycode 31. The significance of the memory contents corresponds specifically to the significance of the similar memory contents in memory 14 of base station 10. The manufacturer code is issued by the manufacturer of remote control operation 20 and designates the latter unambiguously. Serial number 15 is a code that is characteristic for the entire device composed of base station 10 and corresponding remote control operations 20 and is identical to the serial number contained in memory 14 of base station 10. Group number 25 distinguishes remote control operations from each other having same serial number 15. The group number is determined by the user in response to the use of the entire device. Encryption keycode 31 is determined by the manufacturer of the technical device corresponding to base station 10, and it is identical to the one present in the base station. In connection with manufacturer code 27 and the challenge signal supplied by base station 10 via signal transmission link 30, the encryption keycode functions to verify the matching to a base station 10.